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EXAMINER

GENCO, BRIAN C

ART UNIT PAPER NUMBER

2615

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/172,665

Applicant(s)

ITO, WATURA

Examiner

Brian C Genco

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9-11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

Applicant's amendment filed December 3, 2004 has been fully considered by the Examiner but is not deemed persuasive.

Applicant's amendment has overcome the 35 U.S.C. 112 rejections previously presented.

Applicant argues that the motivation statement of motivation appears to be a design choice motivation and is insufficient to establish proper motivation to combine the references.

In response, Examiner notes that the motivation was provided by explicit teaching in the JEIDA article cited. As such the motivation was in no way a design choice, although one skilled in the art would clearly recognize that it is a mere matter of design choice as to which of a plurality of well known and readily available image formats an image file will be stored in.

Applicant argues that the Examiner provided no motivation as to why one skilled in the art would specifically select the EXIF standard.

In response, Examiner notes that motivation of placing the image data in a standard format in association with attribute data was provided which was explicitly taught by the JEIDA article. So as to further Explain the position maintained by the Examiner it is noted that one skilled in the art would clearly recognize the inherent advantages of placing data in a standard format, namely allowing for greater data portability and interoperability. Further, Examiner notes that the EXIF file format in particular is advantageous for storing attribute data along with the image data in a standard format. This was the whole concept driving the creation of the EXIF file format. As such, there is explicit motivation provided in the references themselves as

Art Unit: 2615

to why one skilled in the art would compress the image data into the EXIF format, namely to place the image data in a standard format that records attribute data along with the image data. Still further, there is suggestion provided in the Kawaoka and Funazaki references of recording attribute data along with the image data.

Applicant argues that the only motivation to store the image data in EXIF would appear to come from Applicant's own disclosure.

In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Furthermore, Examiner requests that Applicant indicate where in the rejection the Examiner relied upon Applicant's <sup>disclosure</sup>~~disclosure~~. It does not appear to the Examiner that any portion or teaching of Applicant's disclosure was found to be cited in Examiner's rejection. As such, it is unclear how Applicant came to the conclusion that the motivation was derived from Applicant's own disclosure. Examiner respectfully request clarification of this matter.

Applicant argues that the disclosure of the instant invention clearly discloses that it is beneficial to convert and store the image data in the EXIF format in order to allow consumers

Art Unit: 2615

owning a photographic camera using film access to services that are provided exclusively for digital cameras.

Examiner respectfully requests that Applicant provide page and line numbers of Applicant's disclosure that provide this teaching. Contrary to Applicant's assertion, the Examiner notes page 4, lines 6-13 that the primary object of the instant invention is to provide an image conversion system which scans pictures recorded on film and puts them in a format that a digital camera would use so that people only using a film camera can use the services that are only available to digital cameras. There is no mention of the EXIF format in particular in this disclosure of the object of the invention.

Examiner also notes page 7, lines 11-18 and in particular lines 17 and 18 where Applicant discloses that the image signal is converted into a digital camera format, "e.g. EXIF". Even though Applicant discloses that the format could be in EXIF there is no disclosure of why Applicant is utilizing the EXIF format in particular.

Examiner also note page 8, lines 4-12 wherein Applicant explicitly discloses that the format can be any one of a plurality of known formats selectable by a user.

As such, even though the rejection previously presented wasn't a design choice rejection, Examiner notes that it is merely a design choice and Applicant's arguments against the propriety of using a design choice rejection are not persuasive.

Applicant argues that none of the references cited provide any motivation to use the EXIF format.

In response, as clearly indicated above the motivation to use the EXIF format is clearly provided in the references themselves.

As Applicant's arguments are not persuasive the grounds of rejection previously presented are repeated herein below.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-7, 9-11, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 9-149352 to Kawaoka) in view of (USPN 5,561,531 to Funazaki) in view of (Japan Electronic Industry Development Association Standard; "Digital Still Camera Image File Format Standard (Exchangeable image file format for Digital Still Camera: Exif) Version 2.1" 1998; pages 1, 3, and 8, herein JEIDA).

Examiner is utilizing USPN 5,784,149 to Kawaoka as a translation of JP 9-149352 to Kawaoka. See MPEP 901.05(III).

In regards to claim 1 Kawaoka discloses an image conversion system comprising:

a digital image generation means which reads out an image on photographic film and generates a digital image signal representing the image (e.g., column 3, lines 12-29; column 4, lines 4-16 wherein Examiner notes that digital processing is preformed on the image data, thus the image data is implicitly digital);

Art Unit: 2615

an image signal recording means which records the digital image signal on a recording medium which can be loaded in the digital camera (e.g., column 6, lines 25-32 wherein a memory card can be loaded in a digital camera).

Kawaoka does not disclose nor preclude that the image signal is converted into EXIF format and stored as such. Examiner notes that Kawaoka does disclose a magnetic record layer 34B at the edge of the film that records attribute data such as preferred printing attributes (e.g., column 3, lines 4-11; column 6, lines 7-19). Examiner further notes that it is extremely well known to provide attribute data of a particular shot such as photometry data, zoom data, focus data, etc. for use in future editing and filing of images as taught by Funazaki (column 4, lines 5-7, lines 25-27, lines 46-49, and lines 58-63; column 6, lines 47-67; column 7, lines 1-35). Therefore it would have been obvious to one skilled in the art at the time of the invention to have further recorded shot data in order to enable future editing and easier filling of images.

Examiner notes that the EXIF standard is a digital image standard that utilizes JPEG compression and associates attribute information to a corresponding to a JPEG image. According to the revision history of Exif Version 2.1 a Version 1.1 was published in May 1997 that added "specifications for optional attribute information" (page 3 of JEIDA; page 8 of JEIDA). Examiner notes that Kawaoka discloses to compress image data prior to recording it in column 6, lines 29-32. Therefore it would have been obvious to one of ordinary skill in the art to have utilized the EXIF standard format as disclosed by JEIDA in order to enable compression according to a standard format and association with the attribute data recorded on the magnetic record layer 34B of Kawaoka according to an international standard.

Art Unit: 2615

In regards to claim 2 Kawaoka discloses to utilize a CCD in column 3, lines 12-24, wherein an image signal produced from a CCD is an analog signal. Examiner notes that the claimed A/D converter is also implicit in the reference since the image data is digitally processed as discussed above.

In regards to claim 3, see Examiner's notes on the rejection of claim 1. Examiner notes that Kawaoka discloses to generate RGB image data on column 3, lines 12-24. Examiner notes that although Kawaoka does not explicitly disclose a color transformation means for converting the digital image signal into an 8-bit digital image signal for the digital camera, it is well known in the art for a color transformation means to convert a digital image signal into an 8-bit digital image signal. Official notice is taken. Therefore it would have been obvious to one of ordinary skill in the art to have utilized a color transformation means for converting the digital image signal into an 8-bit digital image signal for the digital camera.

In regards to claims 5-7 see Examiner's notes on the rejection of claim 1-3.

In regards to claims 9-11 see Examiner's notes on the rejection of claim 1-3.

In regards to claims 15-17 see Examiner's notes on the rejection of claim 1, 5, and 9 respectively. Examiner notes that services such as an A/D converter, digital processing of image data, and storage in a memory card are exclusive to a digital camera.

Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over (JP 9-149352 to Kawaoka) in view of (USPN 5,561,531 to Funazaki) in view of (Japan Electronic Industry Development Association Standard; "Digital Still Camera Image File Format Standard



Art Unit: 2615

(Exchangeable image file format for Digital Still Camera: Exif) Version 2.1” 1998; pages 1, 3, and 8, herein JEIDA) in view of (USPN 6,253,023 to Fukushima).

In regards to claim 14 none of Kawaoka, Funazaki, nor JEIDA disclose nor preclude a recording medium selecting means for selecting a desired recording medium from a plurality of types of recording mediums which can be loaded into a digital camera.

Fukushima discloses a recording medium selecting means (column 12, lines 55-65; column 13, lines 11-21 and 33-44; column 27, line 55 – column 28, line 17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have included Fukushima’s recording medium selecting means since it is known in the art that various types of recording medium can be loaded in a digital camera and since Kawaoka discloses that the image data can be recorded on various types of recording medium (column 6, lines 27-29).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2615

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 703-305-7881 or by fax at 703-746-8325. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm. Due to the impending move of the Patent and Trademark Office this contact information will soon change. Effective on or around March 2, 2005 Brian C. Genco will be able to be reached by telephone at 571-272-7364 or by fax at 571-273-7364.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thai Tran can be reached at 703-305-4725. Effective on or around March 3, 2005 Thai Tran can be reached at 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco  
Examiner  
Art Unit 2615

February 18, 2005

  
THAI TRAN  
PRIMARY EXAMINER